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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,908	04/15/2004	Jac-Hong Park	A33914--G- 067515.0172	7609

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BAKER BOTTS LLP  
44TH FLOOR  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112-4498

EXAMINER

APPIAH, CHARLES NANA

ART UNIT PAPER NUMBER

2686

DATE MAILED: 12/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/824,908	PARK ET AL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Charles N. Appiah	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 250-304 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 250-304 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on September 21, 2005 have been fully considered but they are not persuasive.

In regard to Applicants' submission that US 6,782,274 (the patent) and the present application lack the required common ownership to support the outstanding non-statutory double patenting rejection by virtue of US 6,782,274 being owned by UTStarcom Korea Ltd., while the present application is owned by Curitel, Inc., examiner maintains that the non-statutory double patenting rejections are still warranted in view of the fact that the present application and the patent shares common inventorship (see MPEP 804 [R-3], CHART II-B).

In view of the above, the non-statutory double patenting rejections using the patent are maintained as repeated below.

### ***Double Patenting***

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101, which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 250-304 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 250-310 of copending Application No. 10/824,928. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

4. Claims 250, 264, 272, 284 and 292 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,782,274. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of the claims of the instant application are broad enough to be encompassed by the claims of the patent.

5. Claims 250-304 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,950,419. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of the claims of the instant application are broad enough to be encompassed by the claims of the patent as such it would have been obvious to one of ordinary skill in the art to implement the claims of the instant application using the claims of the patent.

6. Claims 250-304 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 250-313 of copending Application No. 10/824,928 ('928 application). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '928 application are broad and can be encompassed by the claims of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 250-304 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 250-291 of copending Application No. 10/824,909 ('909 application). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant are broad enough and can be implemented using the limitations of the '909 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 250-304 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 250-291 of copending Application No. 10/824,891 ('891 application). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are broad and can be implemented using the limitations of the '891 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 250-304 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 250-291 of copending Application No. 10/824,927 ('927 application). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are broad and can be implemented using the limitations of the '927 application by one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 250, 259, 264, 271 272,278, 284,291, 292 and 298 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 258, 267, 275 and 283 of copending Application No. 10/825,280 ('280 application). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are broad and can be implemented using the limitations of the '280 application by one of ordinary skill in the art.


This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles N. Appiah whose telephone number is 571 272-7904. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**CHARLES APPIAH**  
**PRIMARY EXAMINER**